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PATENT APPLICATION

ATTORNEY DOCKET NO. 200208971-1

IN THE  
UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor(s): Winthrop Childers

Confirmation No.: 7057

Application No.: 10/645,185

Examiner: SALLARD, Shannon S.

Filing Date: August 21, 2003

Group Art Unit: 3628

Title: Projector Reservation System and Method

Mail Stop Appeal Brief - Patents  
Commissioner For Patents  
PO Box 1450  
Alexandria, VA 22313-1450

TRANSMITTAL OF REPLY BRIEF

Transmitted herewith is the Reply Brief with respect to the Examiner's Answer mailed on November 13, 2008 .

This Reply Brief is being filed pursuant to 37 CFR 1.193(b) within two months of the date of the Examiner's Answer.

(Note: Extensions of time are not allowed under 37 CFR 1.136(a))

(Note: Failure to file a Reply Brief will result in dismissal of the Appeal as to the claims made subject to an expressly stated new ground rejection.)

No fee is required for filing of this Reply Brief.

If any fees are required please charge Deposit Account 08-2025.

Respectfully submitted,

Winthrop Childers

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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Winthrop Childers  
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**REPLY BRIEF**

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Sir:

This is a Reply Brief under Rule 41.41 (37 C.F.R) in response to the Examiner's Answer of November 13, 2008 (the "Examiner's Answer" or the "Answer"). In Section 10, the Answer contains a response to some of the arguments made in Appellant's brief. Appellant now responds to the Examiner's Answer as follows.

**Status of Claims**

Claims 1-33 are pending in the application and stand finally rejected. Accordingly, Appellant appeals from the final rejection of claims 1-33.

**Grounds of Rejection to be Reviewed on Appeal**

The Answer clarified the grounds of rejection which are as follows. In particular, the Answer expressly adds “Official Notice” in support of the rejection of claims 10, 12 and 13.

(1) Claims 1, 5, and 7 were rejected under 35 U.S.C. § 103(a) as being unpatentable over the combined teachings of U.S. Patent App. Pub. No. 2004/00064355 to Dorenbosch et al. (“Dorenbosch”) and U.S. Patent App. Pub. No. 2004/0039723 to Lee et al. (“Lee”).

(2) Claims 2 and 6 were rejected under 35 U.S.C. § 103(a) as being unpatentable over the combined teachings of Dorenbosch, Lee and Official Notice taken by the Examiner.

(3) Claims 3, 4, and 31 were rejected under 35 U.S.C. § 103(a) as being unpatentable over the combined teachings of Dorenbosch, Lee and U.S. Patent App. Pub. No. 20060288229 to Hamid et al. (“Hamid”).

(4) Claims 8, 11, 14 and 29 were rejected under 35 U.S.C. § 103(a) as being unpatentable over the combined teachings of Dorenbosch, U.S. Patent No. 2006/0010317 to Lee (“Lee-2”) and Lee.

(5) Claim 9 was rejected under 35 U.S.C. § 103(a) as being unpatentable over the combined teachings of Dorenbosch, Lee, Lee-2 and U.S. Patent No. 5,124,912 to Hotaling et al.

(6) Claims 10, 12, and 13 were rejected under 35 U.S.C. § 103(a) as being unpatentable over the combined teachings of Dorenbosch, Lee, Lee-2 and Official Notice.

(7) Claims 15, 18-22, and 26 were rejected under 35 U.S.C. § 103(a) as being unpatentable over the combined teachings of Dorenbosch, Lee and U.S. Patent No. 7,143,177 to Johnson et al. (“Johnson”).

(8) Claim 16 was rejected under 35 U.S.C. § 103(a) as being unpatentable over the combined teachings of Dorenbosch, Lee, Johnson and Hamid.

(9) Claims 17 and 27 were rejected under 35 U.S.C. § 103(a) as being unpatentable over the combined teachings of Dorenbosch, Lee, Johnson and U.S. Patent App. Pub. No. 2003/0208565 to Nishihara et al. (“Nishihara”).

(10) Claims 23-25 and 28 were rejected under 35 U.S.C. § 103(a) as being unpatentable over the combined teachings of Dorenbosch, Lee, Johnson, Hamid and Official Notice taken by the Examiner.

(11) Claim 30 was rejected under 35 U.S.C. § 103(a) as being unpatentable over the combined teachings of Lee, Johnson and Hamid.

(12) Claim 32 was rejected under 35 U.S.C. § 103(a) as being unpatentable over the combined teachings of Dorenbosch, Lee, Hamid and Johnson.

(13) Claim 33 was rejected under 35 U.S.C. § 103(a) as being unpatentable over the combined teachings of Dorenbosch, Lee, Hamid and Nishihara.

According, Appellant hereby requests review these grounds of rejection in the present appeal.

Appellant notes here that each and every ground of rejection relies upon the teachings of Lee (U.S. Patent App. Pub. No. 2004/0039723 to Lee et al.). As Appellant has demonstrated on the record, Appellant’s invention occurred before the priority date of Lee, rendering Lee invalid prior art against the present application.

### Argument

The “Response to Arguments” section of the Answer deals almost exclusively with the arguments in favor of claim 1, 5 and 7. In treating all the *other* claims at issue in this Appeal, the Answer merely refers, in a single paragraph, to the Arguments already made with regard to claims 1, 5 and 7.

Before addressing this “Response” in the Answer, Appellant wishes to focus on several claims other than 1, 5 and 7.

#### (1) Claim 8:

Claim 8 recites:

A method of requesting a projector and a presentation venue reservation, comprising:

selecting the presentation venue having one or more available projectors in accordance with a venue selection criteria for a presentation and associated presentation data (*Appellant’s specification, paragraph 0018*);

selecting a projector according to a projector or selection criteria for the presentation and one or more available projectors at the venue (*Appellant’s specification, paragraph 0018*)

selecting a level of security for storing the presentation data to protect the presentation data from unauthorized access (*Appellant’s specification, paragraph 0018*); and

upload the presentation data to a reservation system server via a network (*Appellant’s specification, paragraph 0018*).

Appellant wishes to note that claim 8 is a *method* claim. Being a *method*, which is a series of steps and not an apparatus, the subject matter of claim 8 is *actually* reduced to practice when the steps of the method are described in sufficient detail that one of skill in the art could practice the method. Consequently, the subject matter of claim 8 was *actually* reduced to practice on or before September 12, 2002 when the Disclosure Document of record had been prepared by the listed inventor and was submitted to the Legal Department of Hewlett-Packard Co.

On the subject of actual reduction to practice, the Answer argues that “Exhibit A is insufficient to establish a reduction to practice because it does not supply an evidence that *the apparatus* described in the claims ever existed prior to October 1, 2002 and worked for its intended purpose.” (Answer, p. 22) (emphasis added). This argument clearly does not apply to *method* claim 8.

As noted above, the method of claim 8 clearly did exist prior to October 1, 2002 as it was completely documented and enabled by the inventor’s Disclosure Document of September 2002. Moreover, there is competent evidence of record that the method of claim 8 did work at that time for its intended purpose.

This evidence is in the form of the declaration by the inventor, Winthrop Childers, dated 26 March 2008. That declaration is evidence of the following declared facts:

1. I [Winthrop Childers] am the inventor of the above-identified patent application filed on August 21, 2003. At the time the patent application was filed, I was an employee of Hewlett-Packard Co.
2. I have experience working for Hewlett-Packard Co. in the field of projectors and related systems and methods, and am at least one of ordinary skill in the field of the above-identified patent application.
3. As part of the process of preparing the above-identified patent application, I prepared a disclosure document to record my invention. This document was prepared prior to October 1, 2002. A copy of this disclosure document was appended to my prior declaration under 37 C.F.R. § 1.131, filed August 21, 2007, which is incorporated herein by reference.
4. *This disclosure document so completely described my invention that, in my opinion, one of ordinary skill in the art would have been able to practice the invention now claimed in the above-identified patent application, without undue experimentation, using that disclosure document prepared prior to October 1, 2002.* (Declaration of 3/26/08, *see* Evidence Appendix) (emphasis added).

This is probative evidence that the *method* of claim 8 existed prior to the effective date of the alleged prior art and functioned at that time for its intended purpose.

Consequently, with regard to at least claim 8, both conception and actual reduction to practice were, by the weight of evidence presented on this record, completed prior to October 1, 2002, prior to the effective date of either Lee or Dorenbosch.

Consequently, neither can be applied against the present invention as valid prior art. For at least this reason, the rejection of claim 8 should not be sustained.

(2) Claim 15:

Claim 15 recites:

15. A method of coordinating a projector and presentation venue reservation, comprising:  
receiving a projector and presentation venue reservation request (*Appellant's specification, paragraph 0019*);  
downloading presentation data from a projector reservation client (*Appellant's specification, paragraph 0019*);  
ensuring availability of presentation software compatible with the presentation data (*Appellant's specification, paragraph 0019*); and  
commencing a presentation including presentation data (*Appellant's specification, paragraph 0019*).

Like claim 8 above, claim 15 is a *method* claim. Consequently, the arguments in the Answer that no such *apparatus* existed prior to the filing of Appellant's application are irrelevant.

As demonstrated above, the evidence of record demonstrated an actual reduction to practice of the *method* of claim 15 prior to the effective prior art date of the Lee and Dorenbosch references. Consequently, the rejection of claim 15 should not be sustained.



(3) Claims 1, 5, and 7 are patentable because Lee is not valid prior art:

Appellant continues to contend that Lee and Dorenbosch cannot be asserted as prior art against the present application based on the evidence of record. If 37 C.F.R. 1.131 is correctly applied, Appellant need show the following.

1) US 2004/006355 to Dorenbosch et al.: conception should be shown prior to Oct. 1, 2002 and due diligence from just before Oct. 1, 2002 until an actual reduction to practice or Aug. 21, 2003.

2) US 2004/0039723 to Lee et al.: conception should be shown prior to April. 3, 2003 and due diligence from just before April 3, 2003 until an actual reduction to practice or Aug. 21, 2003.

Appellant wishes to note on the record that this application was prepared by an attorney who is no longer working with Hewlett-Packard Co., the assignee. As a result, the undersigned has not had access to the records maintained by that attorney in providing evidence to support Appellant's diligence in filing this application. The inventor of this application is also no longer a Hewlett-Packard employee and has had no evidence to provide other than what has already been stated in the Declarations under Rule 131 that are of record. Under these circumstances, Appellant must request the indulgence of the Board in clarifying the record.

With regard to Lee, there is only a four month period during which diligence must be shown. Appellant has thought that it would be clear to those engaged in U.S. patent practice that a four month period is a perfectly reasonable period during which an Appellant may work with an attorney to draft and file a patent application, such as occurred in this case on August 21, 2003. This would include the time taken for the attorney to begin the project consisted with other unrelated projects on the attorney's docket and the time taken to work out an appropriate claim strategy beyond merely documenting the subject matter of the invention.

In the Answer, the Examiner notes that “it is not clear from [the Inventor’s statements] that [the] period in which the draft applications were generated were only during the previously mentioned four month period.” (Answer, p. 23). Because the Examiner has raised this question, which Appellant takes as a request for further details, the undersigned, as a registered practitioner, declares that, based on documentary evidence in the possession of the undersigned, the following facts should be considered on this record.

Prior to September 12, 2002, the inventor conceived of the invention now claimed in this application and prepared the Disclosure Document, of record. The Disclosure Document was submitted to the Hewlett-Packard Legal Department on September 12, 2002 and receipt was acknowledged on September 23, 2002.

Because Hewlett-Packard processes thousands of invention disclosures from employees each year, a strict selection process is used to determine which disclosures will be the subject of a patent application. This process is necessary to respect the limited resources of both Hewlett-Packard Co. and the U.S. Patent and Trademark Office. Between September 23, 2002 and December 26, 2002, the Disclosure Document in this case went through this internal review process and was finally selected for preparation of a corresponding patent application.

At that time, it was the practice of Hewlett-Packard to send such a Disclosure Document to one or more outside counsel with a Request for Quote (RFQ) asking that each queried attorney give a price at which that practitioner would draft the desired patent application. Again, such a process is necessary to maximize the limited resources of Hewlett-Packard for preparing patent applications. After responses are received from the pool of outside counsel quoting the project, consideration is also given to the subject matter expertise and past work product of those outside counsel. After all relevant factors are considered, a

specific attorney is selected to draft the patent application. The RFQ process started in this application on December 26, 2002, but was hampered by the holiday season.

Following the RFQ process, Mr. Tim Myers (Reg. No. 42,919), a representative of Hewlett-Packard, signed an agreement with the attorney who drafted this particular application, Mr. Leland Wiesner (Reg. No. 39,424) on April 14, 2003. It is Hewlett-Packard's express policy that an attorney not start drafting a patent application until an RFQ has been signed by both parties.

From April 14, 2003, the present application would have been on Mr. Wiesner's docket along with other earlier-assigned projects. The present application was completed and filed on August 21, 2003. As stated in the Declaration of Winthrop Childers, of record, from April 14, 2003 until August 21, 2003, "[f]ollowing my conception prior to October 1, 2002, I worked diligently with the Patent Attorney, Leland Wiesner, Esq. to prepare the patent application filed on August 21, 2003 thereby constructively reducing the invention to practice. During this time period, the patent attorney prepared one or more drafts of the application for my comment. With my comments, the patent attorney revised one or more portions of the application, claims and/or figures to accommodate my suggestions." (Declaration of 8/17/07, Para. 6).

Given these statements, Appellant again respectfully submits that adequate diligence was used from September 12, 2002 to August 21, 2003 when the present application was filed. Therefore, neither Lee nor Dorenbosch should be considered valid prior art against the present application. Consequently, the rejections which rely on either Lee or Dorenbosch should not be sustained.

Claims 10, 12, and 13:

The Answer adds “Official Notice” as a basis for rejecting claims 10, 12 and 13. Appellant respectfully submits that the “Official Notice” has not been substantiated as required to serve as a basis for rejecting claims 10, 12 and 13.

Appellant expressly does not acquiesce to the taking of Official Notice. Appellant respectfully requests that the Examiner provide an affidavit to support the Official Notice taken, as required by 37 CFR 1.104(d)(2) and MPEP § 2144.03. Until such evidence is of record, the rejection of claims 10, 12 and 13 should not be sustained.

In view of the foregoing, it is submitted that the final rejection of the pending claims is improper and should not be sustained. Therefore, a reversal of the Rejection of November 13, 2007 is respectfully requested.

Respectfully submitted,

DATE: January 13, 2009

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